

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

## PCT

To:

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22 MAR 2005

CARDIFF

NOTIFICATION OF TRANSMITTAL OF  
THE INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT  
(PCT Rule 71.1)

Date of mailing  
(day/month/year)

18.03.2005

Applicant's or agent's file reference  
KTC/P501162WO

### IMPORTANT NOTIFICATION

International application No.  
PCT/GB 03/05242

International filing date (day/month/year)  
01.12.2003

Priority date (day/month/year)  
30.11.2002

Applicant  
MARKES INTERNATIONAL LIMITED et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international preliminary examining authority:



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## PATENT COOPERATION TREATY

## PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT  
(PCT Article 36 and Rule 70)

Applicant's or agent's file reference KTCP501162WO		<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/GB 03/05242	International filing date (day/month/year) 01.12.2003	Priority date (day/month/year) 30.11.2002	
International Patent Classification (IPC) or both national classification and IPC G01N1/00			
Applicant MARKES INTERNATIONAL LIMITED et al.			
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 5 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of sheets.</p>			
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the opinion</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>			
Date of submission of the demand  21.05.2004		Date of completion of this report  18.03.2005	
Name and mailing address of the international preliminary examining authority:   European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016		Authorized Officer  Bockstahl, F  Telephone No. +31 70 340-3652	



10/536663

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/GB 03/05242

**JC20 Rec'd PCT/PTO 27 MAY 2005**

**I. Basis of the report**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

**Description, Pages**

1-8 as originally filed

**Claims, Numbers**

1-21 as originally filed

**Drawings, Sheets**

1/2-2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-21
Inventive step (IS)	Yes: Claims	
	No: Claims	1-21
Industrial applicability (IA)	Yes: Claims	1-21
	No: Claims	

2. Citations and explanations

**see separate sheet**

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Reference is made to the following documents:

- D1:** US-B-6 409 9681 (TAKAHASHI KATSUAKI) 25 June 2002 (2002-06-25)
- D2:** US 2002/157483 A1 (LIN MIN-NAN ET AL) 31 October 2002 (2002-10-31)
- D3:** EP-A-0 459 677 (THERMEDICS INC) 4 December 1991 (1991-12-04)
- D4:** US-A-5 014 541 (CATES MARION ET AL) 14 May 1991 (1991-05-14)
- D5:** PATENT ABSTRACTS OF JAPAN vol. 018, no. 574 (P-1821), 2 November 1994 (1994-11-02) & JP 06 213784 A (MITSUI KINZOKU SHIGEN KAIHATSU KK), 5 August 1994 (1994-08-05)
- D6:** US-A-5 402 668 (MURAKAMI AKI A ET AL) 4 April 1995 (1995-04-04)
- D7:** EP-A-1 004 871 (MARKES INTERNATIONAL LIMITED) 31 May 2000 (2000-05-31)

2. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of **independent claims 1, 11 and 16** is not new in the sense of Article 33(2) PCT.

2.1 The document **D1** discloses (see abstract; figures 1-11; column 1, line 6 - column 2, line 21; column 2, line 23 - column 3, line 62):

an analytical apparatus for automatically carrying out a plurality of analytical steps, which apparatus includes:  
a releasing device (first pipetting device) for releasing a sample from a sampling tube (reaction container);  
a device for analysing a first portion of the released sample;  
a collecting device (backup reaction container) for collecting a second portion of the released sample;  
a device for re-releasing (second pipetting device) the collected said second portion of the sample; and  
a device for analysing the re-released portion of the sample.

The subject-matter of **independent claim 1** is therefore not new.

2.2 The same reasoning applies, mutatis mutandis, to the subject-matter of the

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corresponding **independent claims 11 and 16** which therefore are also considered not new.

- 2.3 The same objections are raised against novelty of **independent claims 1, 11 and 16** having regard to the disclosure of documents **D2 to D7**, see the corresponding passages cited in the search report.
3. **Dependent claims 2-10, 12-15, 17-21** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents **D1 to D7** and the corresponding passages cited in the search report.